Remarks/Arguments

The Office Action mailed June 4, 2006 has been reviewed and carefully considered. Claims 1-35 are pending in this application. No new matter has been added. Reconsideration of the above-identified application, in view of the following remarks, is respectfully requested.

Rejection under 35 U.S.C. §102(b)

Claims 1-35 currently stand rejected under 35 U.S.C. §102(b). The Examiner has interpreted portions of the Exhibits submitted by the Applicant as evidence of public use or sale prior to the critical date. The Applicant respectfully traverses the Examiner's assertion that the present principles, as claimed, were embodied in a product that was shown or offered for sale more than 1 year prior to the effective filing date of the present application.

The present application claims the benefit of United States Patent Application No. 09/215,161, filed on December 18, 1998. Thus, the critical date, with respect to §102(b) would be one year prior to the effective filing date, namely, December 18, 1997.

Regarding the application of the 1997 Annual Report for §102(b) purposes, the Applicant respectfully asserts that the 1997 Annual report has no bearing on the patentability of claims 1-35, as the 1997 Annual Report was not published until 1998. In support of this, the Applicant respectfully draws the Examiner's attention to page 6, which illustrates the stock market and dividend information for the fiscal year ending December 31, 1997. In order to accurately report the stock price information, the report must have been written *after* December 31, 1997. There would be no way for the 1997 Annual Report to be published, or otherwise available to the public, any time prior to 1998. Furthermore, other

elements of the Annual report, such as the accountant's certification date February 1998, illustrate the Annual Report was not published until 1998. Therefore, the 1997 Annual Report does not affect the patentability of claims 1-35.

The Applicant further respectfully draws the Examiner's attention to Exhibit C, the Preliminary Sales Manual, and more specifically, to the price list on pages 8-10. There, the Examiner can see that the CameraMan STUDIO line of products is quite extensive, ranging from camera system, to cable and keypads. The majority of these products do not include the CameraMan STUDIO software. Additionally, all of the products having the CameraMan STUDIO software have no release date listed. Thus, at the time this manual was printed, it could not yet be determined when the product would be released. Furthermore, the Preliminary Sales manual is marked CONFIDENTIAL. Such confidential sales manuals are not distributed at trade shows to prospective buyers, and should not be considered sales material. Therefore, the Applicant respectfully asserts that the Preliminary Sales Manual does not affect the patentability of claims 1-35.

Additionally, the Examiner has cited the Preliminary Sales Literature as disclosing the use of transition macros. However, the cited Preliminary Sales Literature, as acknowledged by the Examiner, merely states that "the powerful Transition Macro feature allows directors to spend their pre-production time inventing new shots, then performing them with a touch of a button" and "Transition Macros used to store complex production sequences, then recall them with a click of a mouse." However, the present principles are not directed to the same features that were listed in the Preliminary Sales Literature. Claim 1, which is exemplary of all of the pending independent claims, recites, inter alia:

"said at least one set comprising at least one segment file which comprises a group of production commands that, when executed, operates to produce a segment of the show, said at least one-segment file *comprising at least one scripted portion* that includes at least *one command activated during a predetermined interval in a script* that undergoes scrolling for display under control of an operator, *and at least one non-scripted portion* that include at least *one command activated independent of the script.*"

The Applicant further urges the Examiner's close reading of Exhibit A, the Preliminary Sales Literature. The Federal Circuit Court of Appeals has distinctly held that "The product offered for sale must be the product that is claimed in the patent." *Space Systems/Loral, Inc. v. Lockheed Martin Corp.*, 271 F.3d 1076, 1080-81 (Fed. Cir. 2001). Here, what is disclosed in Exhibit A is not claimed.

Even when read in the broadest interpretation, the two sentences in the Preliminary Sales Literature regarding Transition Macros makes no reference to the combination of elements and specifics the above listed elements of claim 1. The cited passages from the Preliminary Sales Literature reference the manual triggering of the Transition macros, specifically "performing them with a touch of a button" and the ability to "recall them with a click of a mouse." No mention or disclosure of the "one command activated during a predetermined interval in a script" or "one command activated independent of the script" appears anywhere in the Preliminary Sales Literature.

Even if the Preliminary Sales Literature were, arguendo, to somehow be interpreted as teaching the elements of the present claims, the Applicant respectfully

asserts that there was no public sale or use of the elements presently claimed. Regarding the Examiner's view of the events prior to the critical date, the Applicant respectfully traverse the Examiner's interpretation of those events.

The Examiner has stated that the invention was graphically disclosed at the NAB 96 trade show. However, according to the Declaration of Alex Holtz, "a PC generated graphic of a sample GUI" was shown. Moreover, as clearly stated by Mr. Holtz, the bulk of the coding on the project that would later become the CameraMan STUDIO software was not complete at the time the sample GUI was shown. Applicants respectfully assert that the CameraMan SUDIO product encompasses so many aspects, that the product was developed in stages. Naturally, certain parts of the CameraMan SUDIO product were developed later than others. The features claimed in the current application were developed after the critical date.

Furthermore, the GUI shown was merely a sample, and cannot constitute public use of the invention any more than a drawing of a concept car constitutes public use of that car. Sample GUIs are frequently shown in the software industry to illustrate the placement of button, sliders, panels and other graphical interface elements. As stated in the Holtz declaration, the features recited in the present claims we not actually developed until after the critical date. The GUI shown at the NAB 96 trade who did not implement the features currently claimed, and thus, where was no public use of the invention at the NAB 96 trade show. Regarding the Preliminary Sales Literature, and other printed materials discussed above, the Declaration of Alex Holtz, explicitly states, in paragraph 2, that at the 96 NAB, "We did not distribute any literature, marketing documents, or other information in printed form."

The Examiner has noted that at the NAB 97 trade show, potential beta test sites were sought, and a list of such potential beta test sites was kept. Additionally, at the NAB 97 trade show, discussions with Rainbow Media group were entered into regarding a possible beta test.

The Examiner has repeatedly equated beta testing with the commercialization of the software embodying the present principles. This is incorrect. The following are several definitions of the term "beta test":

> Beta test - 2. Computers. a quality-control technique in which hardware or software is subjected to trial in the environment for which it was designed, usually after debugging by the manufacturer and immediately prior to marketing. – "beta test." *Dictionary.com Unabridged (v 1.1)*. Random House, Inc. 15 May. 2007. <Dictionary.com http://dictionary.reference.com/browse/beta test>.

> Beta test - The final stage in the testing of new software before its commercial release, conducted by testers other than its developers. "beta test." *The American Heritage® Dictionary of the English Language, Fourth Edition*. Houghton Mifflin Company, 2004. 15 May. 2007. <Dictionary.com http://dictionary.reference.com/browse/beta test>.

> Beta test - A test for a computer product prior to commercial release. Beta testing is the last stage of testing, and normally can involve sending the product to *beta test sites* outside the company for real-world exposure or offering the product for

a free trial download over the Internet. Beta testing is often preceded by a round of testing called alpha testing. "beta test." - *Webopedia*. Internet.com, 15 May. 2007.<Webopedia.com http://www.webopedia.com/TERM/b/beta_test.html>.

As can be seen from the above definitions, beta testing is a testing phase that virtually all production software goes through before being released for sale. Here, simply soliciting beta test candidates did not rise to the level of an offer for sale. Simply seeking outside assistance with real world testing and development is in no way a sale of the product.

Furthermore, the product in question was not even ready for beta testing at the time of the NAB 97 tradeshow. Paragraph 8 of the Holtz declaration specifically states that "I told *all that asked* that *neither a production level or beta level system* of the CameraMan STUDIO was available." From this, it can be seen that the invention was *not* offered for sale, and that, in fact, any attempts by prospective purchasers to enter into sales negotiations were *actively denied.*

It should be further noted that the beta testing agreement was not even signed until December 19, 1997, after the critical date. No purchaser would be willing to spend tens, or even hundreds, of thousands of dollars on a software suite that had never been tested under real world conditions. The beta testing was a necessary testing and refining process undertaken prior to the invention being ready for patenting.

The Examiner has repeatedly stated that the invention was in public use since April 1997. However, the Examiner has failed to take into account the Holtz declaration which states that the elements claimed in the present application were not developed until

after the critical date. Specifically, the Holtz declaration states that several features, such as "Transition Macro hotkeys, editing of a transition macro" and "triggering an event from a teleprompter" were not developed until after the critical date. Thus, it would have been impossible for the claimed features to have been in public use prior to the critical date. Simply because a basic transition macros had been developed prior to the critical date does not mean that the feature was fully fleshed out, tested, and complete.

The Applicant respectfully directs the Examiner's attention to *In re Smith*, 714, F2d 1127, which states that "To come within experimental use exception contained in statutory public-use bar to patentability, experiment to improve and perfect invention must be real purpose in public use and not merely incidental or subsidiary." As repeatedly defined above, beta testing is merely testing of a nearly complete product, done *prior* to commercialization. Again, the Examiner has incorrectly confused beta testing with a sales demonstration. The beta testing talks with the Rainbow Media Group were not sales discussions, but were mere negotiations to partner with Rainbow Media Group for real world testing.

Due to the fact that the features specifically claimed in the present application were not developed or disclosed until well after December 18, 1997, and the product was in development, was not offered for sale, or even ready for sale prior to December 18, 1997, the Applicants respectfully assert that the present claims cannot be barred under 35 U.S.C. §102(b). Applicants respectfully request the withdrawal of the Examiner's §102(b) rejection.

Request for Additional Information

The Examiner has requested additional information relating to the stages of completion of the invention with regard to the Tradeshows attended in 1997. Additionally, the Examiner has made a request for a copy of the source code of the invention, pursuant to a telephone conference with the Applicant's representative.

Currently the Applicant and their representatives have been unable to locate a copy of the original source code after a diligent search. At this point, the Applicant respectfully asserts that the Examiner is in possession of a copy of all materials known to exist regarding the state of development of the invention that would affect the patentability of claims 1-35. The Applicant respectfully requests that prosecution of Application proceed while the Applicant continues the search for the source code of the invention showing the development of the invention during 1997.

Rejection under 35 U.S.C. §102(e)

Claims 1-15, 18-24, 26-28, 30-32, 34, and 35 stand rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,038,573 to Parks (hereinafter "Parks"). The §102(e) rejection is respectfully traversed.

Claim 1, which is exemplary of the remaining claims rejected under §102(e), recites, inter alia, creation of a segment file "comprising *at least one scripted portion that includes at least one command activated during a predetermined interval in a script* that undergoes scrolling for display under control of an operator, *and at least one non-scripted portion that include at least one command activated independent of the script.*"

As used in the current claims, the term "scripted" means that a transition macro is set to be executed at a predetermined point. To be "non-scripted" means that a transition macro may be executed at any point, without relation to a particular time or point in a script. Claim 1 recites a segment file that has *both* scripted and non-scripted portions.

The Applicant respectfully asserts that Parks fails to teach, or even suggest, a segment file having "at least one scripted portion that includes at least one command activated during a predetermined interval in a script" and "at least one non-scripted portion that include at least one command activated independent of the script." These elements are explicitly recited in claim 1. Independent claims 8, 10, 18, 26 and 32 also have the same, or analogous elements recited therein.

In addressing the Applicant's previous arguments that Parks failed to anticipate all of the elements of the claims, the Examiner has stated:

> "Parks' figure 2C discloses a segment file that comprises a scripted portion in story area 243, and a non-scripted portion in the machine code area 242. Scripted portion 243 comprises command 245 that activated when the script undergoes scrolling. Non-scripted portion includes machine instructions that can be activated independent from the scrolling script, i.e., the user may select and execute a command from the machine code area 242 (8:25-65)." (See, Response to Argument, Office Action mailed June 4, 2007).

It appears that the Examiner has assumed the position here that the machine codes of Parks are *not* executed automatically or "scripted". However, the Applicant

respectfully notes that the Examiner has asserted a contrary position regarding the machine codes of Parks in several of the Applicant's co-pending applications.

The Applicant respectfully asserts that the Examiner has incorrectly equated the *non-script (text) portion* of the Parks *interface* with the non-scripted portion of the *segment file* of claim 1. Simply because the machine codes of Parks do not appear in the same interface window as the script *text* does not mean that the Parks machine codes are not scripted.

Column 8, lines 27-51 of Parks specifically state that the machine codes are tied directly to the text of the script:

> The example screen 240 includes a template area 241, a machine code area 242, and a story area 243. The template area 241 is used to contain metadata the news story. The template of the story either may be embedded in the story area or may be displayed separately in the template area 241. The machine code area 242 contains codes to control machines during broadcast. *Each code is stored in a machine code object that contains all the text for the machine code and a corresponding insertion point which is visible in the story area 243 for the script.* The story area 243 contains the text of the news story. In a script for a news story, the story area 243 contains the text that, for example, may be displayed on a teleprompter to be read by an anchor person. *A reference mark 245 indicates the place within the story area where a machine instruction 246 should be executed. The reference mark 245 provides a link to the machine instruction 246.* If a news story document is moved to another section of the news broadcast, or of the text associated with the reference mark is moved within the new story the

corresponding machine instruction 246 would be moved with it. If the story was deleted from the broadcast, or if the text associated with the reference mark is deleted from the story, the corresponding machine instruction would be deleted.

Parks completely fails to teach, or even suggest, any non-scripted portions of a segment file. From the above cited passage of Parks, it can be clearly seen that the machine codes are linked to the text by reference marks. ("The reference mark 245 provides a link to the machine instruction 246."). The reference marks are used to execute the machine instructions at a predetermined point in the script. ("A reference mark 245 indicates the place within the story area where a machine instruction 246 should be executed."). Simply showing the body of the machine code separately from the script text does not render the machine codes of Parks non-scripted, it merely means that the machine codes are not part of the text displayed on a teleprompter. ("In a script for a news story, the story area 243 contains the text that, for example, may be displayed on a teleprompter to be read by an anchor person."). While the machine codes are not text read by an anchor person, they are still scripted. Executing the machine codes at a specific point in the text of the script is the definition of "scripted".

Furthermore, the reference marks linking machine codes to specific points in the text of the script, as taught by Parks, prevent any ability to execute a command "independent of the script". In order to provide such abilities, the interface of Parks would necessarily need the ability to monitor a production 'on the fly', or while production was actually being executed. Otherwise, a producer would not be able to accurately trigger the execution of a machine code independent of the scrolling script.

Parks makes no such facility available. Additionally, Parks would have to provide some listing, or menu, of available machine codes, so that appropriate machine codes could be selected during production for non-scripted activation. Parks makes no such teaching. The only executable commands taught by Parks are the machine codes cited by the Examiner, which, as also cited by the Examiner are shown in a machine code area, and are linked to fixed points in the text of a story. Even an artisan highly skilled in the software development and television production field would require extensive development, testing, and experimentation to add the claimed features to Parks. As such, Parks cannot anticipate, or even render obvious all of the features of claim 1.

The Applicant respectfully draws the Examiner's attention to MPEP §2131: "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." MPEP §2131, citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Here, Parks has failed to show at least a segment file comprising "a segment file "comprising *at least one scripted portion that includes at least one command activated during a predetermined interval in a script* that undergoes scrolling for display under control of an operator, *and at least one non-scripted portion that include at least one command activated independent of the script.*" Therefore, having failed to show all of the elements of the claim, Parks cannot anticipate, or even render obvious, all of the elements of claim 1. Claim 1, is thus, patentable over Parks for at least the reasons cited above. Likewise, independent claims 8, 10, 18, 26 and 32 recite the same, or analogous

elements, and are, therefore, patentable over Parks for at least the same reasons as discussed for claim 1.

Claims 2-7 depend from Claim 1 or a claim which itself is dependent from Claim 1 and, thus, include all the limitations of Claim 1. Claim 9 depends from Claim 8 and thus include all the limitations of Claim 8. Claims 11-15 depend from Claim 10 or a claim which itself is dependent from Claim 10 and, thus, include all the limitations of Claim 10. Claims 19-24 depend from Claim 18 or a claim which itself is dependent from Claim 18 and, thus, include all the limitations of Claim 18. Claims 27-28 and 30-31 depend from Claim 26 or a claim which itself is dependent from Claim 26 and, thus, include all the limitations of Claim 26. Claims 34-35 depend from Claim 32 and thus include all the limitations of Claim 32. Accordingly, Claims 2-7, 9, 11-15, 19-24, 27-31, and 34-35 are patentably distinct and non-obvious over the cited reference for at least the reasons set forth above with respect to Claims 1, 8, 10, 18, 26, and 32, respectively.

The Applicant, therefore, respectfully requests the withdrawal of the §102(e) rejection of claims 1-15, 18-24, 26-28, 30-32 and 34-35.

Rejection under 35 U.S.C. §103(a)

Claims 16, 17, 25, 29 and 33 stand rejected under 35 U.S.C. §103(a) as being unpatentable in view of Parks. The §103(a) rejection is respectfully traversed.

Under MPEP §2143.03, "To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." (MPEP §2143.03, citing *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)). "If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending

therefrom is nonobvious." (MPEP §2143.03, citing *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)).

Claim 16 recites the element of "each segment file comprising at least one scripted portion that includes at least one command activated during a script that undergoes scrolling for display under control of an operator and at least one non-scripted portion that includes at least one command activated independent of the script", similar to the elements discussed above for claim 1. Likewise, claims 17, 25, 29, and 33 recite similar elements, or depend from claims that recite the same, or similar, elements.

The Applicant respectfully contends that, as detailed above for claim 1, Parks fails to teach or suggest, in any way, "each segment file comprising at least one scripted portion that includes at least one command activated during a script that undergoes scrolling for display under control of an operator and at least one non-scripted portion that includes at least one command activated independent of the script." Therefore, the Applicant asserts that, having failed to teach or suggest all of the claim limitations of claims 16-17, 25, 29 and 33, Parks cannot render these claims obvious, for at least the reasons detailed above for claim 1. Thus, the Applicant respectfully requests the withdrawal of the Examiner's §103(a) rejection of claims 16-17, 25, 29 and 33.

In view of the foregoing, Applicant respectfully requests that the rejections of the claims set forth in the Office Action of June 4, 2007 be withdrawn, that pending Claims 1-35 be allowed, and that the case proceed to prompt issuance of Letters Patent in due course.

It is believed that no additional fees or charges are currently due. However, in the event that any additional fees or charges are required at this time in connection with the application, they may be charged to applicant's representatives Deposit Account No:07-0832

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